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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,619	12/29/2000	Jesse Salb	04646.P003D	1327
7590 03/24/2004				
James C. Scheller, JR. BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP Seventh Floor 12400 Wilshire Boulevard Los Angeles, CA 90025-1026			EXAMINER JONES, DAMERON LEVEST	
			ART UNIT 1616	PAPER NUMBER

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,619

Applicant(s)

SALB, JESSE

Examiner

D. L. Jones

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/11/03; 11/15/02; 11/18/02; & 2/20/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-70 and 76-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65-70 and 76-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>see office action</u> . | 6) <input type="checkbox"/> Other: _____ |

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the RCE (request for continuous examination) filed 12/11/03. In addition, the amendment filed 12/11/03 wherein claim 76 was amended is acknowledged.

Note: Claims 65-70 and 76-79 are pending.

RESPONSE TO APPLICANT'S ARGUMENTS/AMENDMENT

2. The Applicant's arguments filed 12/11/03 to the rejection of claims 65-70 and 76-79 made by the Examiner under 35 USC 112 have been fully considered and deemed persuasive-in-part for the reason set forth below.

112 First Paragraph Rejection

The rejection of claims 65-70 and 76-79 under 35 USC 112, first paragraph, as failing to comply with the written description requirement is MAINTAINED for reasons of record in the office action mailed 6/4/03 and those set forth below.

Applicant asserts that support for "X is aryl" is in the Examples 1 and 2 on pages 30 and 33, respectively, wherein the aryl is substituted with three atoms of iodine and optionally, further substituted with an alkyl group.

Examples 1 and 2 are directed to specific substituted aryl groups, not all aryl groups. Thus, the specification does not provide support for the broad term 'aryl', but is enabled and disclose specific X moiety aryl groups. In addition, Applicant states that support for the aryl group being further substituted is also supported by Examples 1 and 2. As stated by Applicant, Examples 1 and 2 disclose iodinated aryl groups that are

optionally *substituted with an alkyl group*. Hence, Applicant neither describes or is enabled for all other substituents on the iodinated aryl group.

Note: It is suggested that Applicant amend independent claim 65 to read "X moiety is an unsubstituted or substituted C1-C8 alkyl, alkoxy, alkylthio, alkenyl, alkylaryl, alkylamino, alkylamido, amido, or arylamido, in which at least one atom is substituted by a radio-opacifying atom of a element with an atomic number of approximately $Z = 35$ to approximately $Z = 74$ or X is an iodinated aryl group optionally substituted with an alkyl group". This statement is consistent with Applicant's specification page 41 and the Examples of the specification.

112 Second Paragraph Rejection

The rejection of claims 65-70 and 76-79 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention is MAINTAINED-IN-PART for the reasons of record in the office action mailed 6/4/03 and those set forth below.

Claims 76-79: The rejection is withdrawn because Applicant has amended the claims to overcome the rejection.

Claims 65-70 and 76-79: The rejection over the phrase 'which may be further substituted' is maintained. Applicant asserts that Examples 2 and 3 disclose iodinated aryl groups that are substituted with alkyl and 2-N-methylcarboxamide; thus, support for 'further substituted' is provide.

The phrase 'which may be further substituted' includes a multitude of possible substituents that may be attached to a structure. However, Applicant has not described

any substituents other than those of Examples 2 and 3 and thus, has no description of another other possible substituents, is neither enabled for any other substituents, and has not clearly set forth what is encompassed by their definition. Hence, the claims are vague and indefinite.

CLARIFICATION OF THE RECORD

3. Review of Applicant's application on the image system, does not show record of a terminal disclaimer submitted for 09/810,130. Thus, Applicant is respectfully requested to include a copy with the next correspondence to the Examiner. It is duly noted that in Applicant response filed 3/13/03, it is stated that a terminal disclaimer accompanied the response to overcome double patenting rejections for 09/810.130 and 09/809,870. However, only the terminal disclaimer for 09/809,870 is of record.

COMMENTS/NOTES

4. Claims 65-70 and 76-79 are allowable over the prior art of record. However, it should be noted that Applicant must address and overcome the 112 rejections above. In addition, it should be noted that the various X has been examined as follows which is consistent with that of the specification (page 41, lines 13-16) and the structures disclosed in Applicant's examples. The X moiety is an unsubstituted or substituted C1-C8 alkyl, alkoxy, alkylthio, alkenyl, alkylaryl, alkylamino, alkylamido, amido, or arylamido, in which at least one atom is substituted by a radio-opacifying atom of a

element with an atomic number of approximately $Z = 35$ to approximately $Z = 74$. In addition, X may be the specific aryl groups of Examples 1-5 in the specification.

5. Copies of all the information disclosure statements present in the instant application are being mailed with this office action. The dates that the information disclosure statements were submitted are 11/15/02; 11/18/02; and 2/20/03.

6. The lined through references on the information disclosure statement submitted 12/29/00 were not present in the instant application or in serial number 09/149,734 as set forth on the information disclosure statement coversheet. Applicant is respectfully requested to submit the document with the next correspondence to the Examiner.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1616

March 19, 2004